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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,377	03/27/2001	Daniel F. Williams	PSTM0041/MRK	5661

29524 7590 04/05/2004

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,377

Applicant(s)

WILLIAMS ET AL.

Examiner

Jamisué A. Webb

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 8, 9 and 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7 and 10-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, 8, 9 and 15-22, drawn to a method of calculating shipping rates using policy rules, classified in class 705, subclass 1.
 - II. Claims 7 and 10-14, drawn to a method of printing and creating a barcode and a tracking number for shipping within an enterprise, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as being able to calculate rates and does not require the use of a tracking number or a barcode. Even though they can be used in the same system, they can be used separately, one to calculate rates and one to track packages. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Marilyn Korshandi on 3/18/04 a provisional election was made without traverse to prosecute the invention of II, claims 7 and 10-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-6, 8, 9 and 15-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

6. The use of the trademarks UPS, USPS, FedEx, Mailboxes Etc., and Airborne Express have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 7, 11, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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9. With respect to Claim 7: the phrase “delegate shipping to another user” is indefinite. Does this mean a particular user can give the authority to ship a package to another user, if so it is unclear to the examiner how a traveler label is involved in the delegation of shipping?

10. With respect to Claim 11: This claim is a run on sentence, therefore it is unclear what is actually being recognized, is it the pre-processing shipping request or is it the request to ship a particular package input by a particular user. The examiner suggests the use of commas to separate the descriptive terms from the actual claimed item.

11. With respect to Claims 13 and 14: the phrase “generate a printable bar-coded pre-processing traveler label” is indefinite. In claim 10, it claims the particular user is restricted from printing, therefore how can it then generate the printable bar-coded label.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Brandien et al. (6,134,561).

14. Brandien discloses the use of a shipping management system usable within a company that generates a barcode tracking label (see abstract, and column 4, lines 1-7).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandien et al. in view of Rabne et al. (6,006,332).

18. With respect to Claim 10: Brandien, as disclosed above, teaches the use of an internal shipping system, but fails to disclose restricting users within the enterprise from printing shipping labels. Rabne, discloses a rights management system for digital media that allows an administrator to set rights for a user to restrict printing certain items (columns 21, lines 8-33). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have the system of Brandien, be able to set administrative rights, such as printing, as disclosed by Rabne, in order to protect the integrity of the system data and to control and monitor the use of shipping system. (See Rabne, Columns 2 and 3)

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19. With respect to Claim 11: See Brandien Figures 2 and 6-9, and corresponding detailed descriptions.
20. With respect to Claim 12: See Brandien Figures 5 and 7 and corresponding detailed descriptions.
21. With respect to Claim 13 and 14: See Brandien abstract, and column 4, lines 1-7.

Conclusion

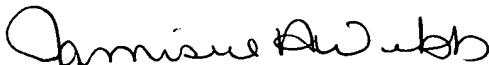
22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Savino et al. (6,015,167) discloses the use of an online shipping system which automatically prints barcodes, Kato et al. (5,971,587) discloses the use of a delivery system, Kadaba et al. (6,285,916) discloses the use of an internal tracking system, Nicholls et al. (5,485,369) discloses the use of a multi-carrier shipping system, Juedes et al. (WO 01/13261A1) discloses the use of an online shipping system, and IBM (NN86091526) discloses the use of an internal shipping and tracking system of ordered parts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jarnisue Webb

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